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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/261,329	03/03/1999	KIM VILBOUR ANDERSEN	4887.204-US	7632
25908	7590	11/14/2005		
NOVOZYMES NORTH AMERICA, INC. 500 FIFTH AVENUE SUITE 1600 NEW YORK, NY 10110				
			EXAMINER SLOBODYANSKY, ELIZABETH	
			ART UNIT 1652	PAPER NUMBER

DATE MAILED: 11/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/261,329

Applicant(s)

ANDERSEN ET AL.

Examiner

Elizabeth Slobodyansky, PhD

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 204-206 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 204 and 206 is/are rejected.
- 7) ☒ Claim(s) 205 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>herewith</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 204-206 are pending.

Board of Patent Appeals and Interferences rendered its decision on September 22, 2005 whereby all of the rejections of record are reversed (112, 1st paragraph, written description and enablement and 112, 2nd paragraph).

Prosecution on the merits of this application is reopened on claims 204-206 considered unpatentable for the reasons indicated below.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 204 and 206 are rejected under 35 U.S.C. 102(b) as being anticipated by Convents et al.

Convents et al (US Patent 5,443,750) teach a cellulase having endoglucanase activity from *Humicola insolens* (SEQ ID NO:2, 305 amino acids). Said SEQ ID NO:2 is 78.8% identical to SEQ ID NO:5 of the instant invention and comprises substitution Q119H (numbering according to SEQ ID NO:1). It further comprises at least a substitution Q4R and thus, anticipates claims 204 and 206.

Claims 204 and 206 are rejected under 35 U.S.C. 102(b) as being anticipated by Schulein et al.

Schulein et al (WO 94/07998, form PTO-1449 filed March 3, 1999) teach a cellulase having endoglucanase activity from *Humicola insolens* (SEQ ID NO:10, 284 amino acids). Said SEQ ID NO:10 is 78.8% identical to SEQ ID NO:5 of the instant invention and comprises substitution Q119H (numbering according to SEQ ID NO:1). It further comprises at least a substitution Q4R and thus, anticipates claims 204 and 206.

The patentability of the product resides in the product and the claimed "modified cellulase" having a given amino acid sequence is indistinguishable from the cellulase from *Humicola* having the same amino acid sequence.

Allowable Subject Matter

Claim 205 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent 5,792,641 (national stage of WO 94/07998, *supra*) and its divisional, US Patent 6,114,296, teach SEQ ID NO:10 (284 amino acids) that is 78.8% identical to

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SEQ ID NO:5 of the instant invention and comprises substitution Q119H (numbering according to SEQ ID NO:1).

US Patent 5,520,838, SEQ ID NO: 2 (305 amino acids) is 78.8% identical to SEQ ID NO:5 of the instant invention and comprises substitution Q119H (numbering according to SEQ ID NO:1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Slobodyansky, PhD whose telephone number is 571-272-0941. The examiner can normally be reached on M-F 10:00 - 6:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, PhD can be reached on 571-272-0928. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Elizabeth Slobodyansky, PhD
Primary Examiner
Art Unit 1652

October 17, 2005



BRUCE KISLIUK, DIRECTOR
TECHNOLOGY CENTER 1600